



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,332	02/13/2001	Keiichi Iwamura	35.G2740	9055

5514 7590 03/31/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/781,332	Applicant(s) IWAMURA, KEIICHI	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-34, 36-42 and 44-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-34, 36-42 and 44-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Request for Reconsideration

1. This is in response to a request for reconsideration file December 9th, 2004. Claims 1, 2-9, 11-34, 36-42 and 44-64 are being reconsidered in this action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2-9, 11-34, 36-42 and 44-64 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rhoads (U.S. PG Pub No. 2003/0128861).
4. As per claims, Rhoads teach 1, 6, 9, 14, 17-19, 34, 39, 42, 47, 50 and 57 a image processing apparatus comprising: user information storing means for storing user information related to a seller or a buyer of the image processing apparatus; and multiplexing means for multiplexing the user information to an output image, wherein said user information is obtained when the image processing apparatus is sold through a network (*see the entire patent, claims 37-100, page 35-37*).

Art Unit: 3621

5. As per claim 3, 11, Rhoads an image processing apparatus further comprising information setting means for setting a predetermined information related to the seller or the buyer of the image processing apparatus; wherein the multiplexing means for multiplexing the predetermined information to an output image (*see the entire patent, claims 37-100, page 35-37*).

6. As per claim 4, 7, 12, 15, 36, 40, 45, 48, Rhoads an image processing apparatus wherein the predetermined information is a public key certification (*see the entire patent, claims 37-100, page 35-37*).

7. As per claim 5, 8, 13, 16, 37, 41, 46, 49, Rhoads an image processing apparatus wherein the predetermined information is information to specify a objective use on a database (*see the entire patent, claims 37-100, page 35-37*).

8. As per claim 20, 27, 51, 58, Rhoads an image processing apparatus wherein the user information includes a public key certification or the account number of the buyer or the information of the buyer's credit card (*see the entire patent, claims 37-100, page 35-37*).

9. As per claim 21, 28, 52, 59, Rhoads an image processing apparatus wherein the user information includes information of the seller or information of date of sale or information selling the image processing apparatus (*see the entire patent, claims 37-100, page 35-37*).

Art Unit: 3621

10. As per claim 22, 29, 53, 60, Rhoads an image processing apparatus wherein the user information is stored according as a driver of the image processing apparatus is downloaded or is installed (*see the entire patent, claims 37-100, page 35-37*).

11. As per claim 23, 30, 54, 61, Rhoads an image processing apparatus wherein the multiplexing is performed by using digital watermark (*see the entire patent, claims 37-100, page 35-37*).

12. As per claim 24, 25, 31, 32, 55, 56, 62, 63, Rhoads a method wherein the digital watermark is added in a spatial area of the output image in a frequency area of the output image (*see the entire patent, claims 37-100, page 35-37*).

13. As per claim 33, 64, Rhoads a method wherein the image processing product includes a personal computer or a scanner or an image processing software (*see the entire patent, claims 37-100, page 35-37*).

Response to Arguments

14. Applicant's arguments filed December 9th, 2004 have been fully considered but they are not persuasive.

a. Applicant argues that the cited reference is not supported in the written description. Applicant further argues that it is believed that they constitute at least part of the new matter which makes the '290 application. As such, it is believed that the subject

Art Unit: 3621

matter disclosed by Claims 37 to 100 of Rhoads have an effective filing date of October 18, 2002 and therefore, do not constitute prior art to the subject application. Accordingly, the rejections are traversed on this basis. Moreover, the Office Action did not indicate what the effective filing date is of the subject matter relied upon for the rejections, or which of the claimed priority applications (if any) are relied upon to support the effective date. However, Examiner respectively disagrees with Applicant characterization of the effective filing date of the prior art. Although the prior art make claims domestic priority under 35 U.S.C. 120 to numerous other applications (some of which predate the subject application), it also claims to be a Continuation-in-part, the prior art also claim priority of provisional Application is a non-provisional-of-provisional application 60/082228, filed April 16, 1998. Therefore, the effective filing date of the cited prior art is established as before the filing date of the Applicant's disclosure and constitute prior art to the application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

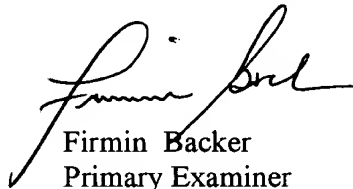
Art Unit: 3621

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Primary Examiner
Art Unit 3621

March 23, 2005